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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,902	11/02/1999	KAZUYUKI OHTSU	FUJY=16.705	9388

26304 7590 12/18/2002

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EXAMINER

FERRIS, DERRICK W

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 12/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.



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Office Action Summary

Application No.

09/431,902

Applicant(s)

OHTSU ET AL.

Examiner

Derrick W. Ferris

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. Examiner notes applicant has filed the same references for IDS filed 11/2/1999 and 6/1/02 (see attached forms).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims are 1-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,356,545 to Vargo et al. ("Vargo").

As to **claims 1, 2, 7 and 8**, Vargo discloses an Internet system able to dynamically select a CODEC (i.e., perform expansion and compression using a broad but reasonable interpretation of the term CODEC) [Abstract]. Specifically, Vargo discloses an invention relating generally to both the Internet and the PSTN (i.e., circuit switched networks) thus creating a motivation as a whole for applying this reference [column 1, lines 15-20]. Vargo presents a gateway 10 for voice communications between an Internet Protocol (IP) network 17 and a circuit switched network 11 [figure 1; column 3, lines 42-56; column 4, lines 36-40]. This gateway uses software to create a session (figure 4) and control the characteristics of a session at a voice port by not only adjusting such factors as the packet size or bundling of a packet [column 7, lines 6-17] but also varying in the selection of a codec per packet as well [column 7, lines 18-27]. Thus examiner notes a

broad but reasonable teaching of either expansion or compression depending on the type of codec employed per packet. Thus examiner notes that should no codec be employed per packet then a tandem free operation (TFO) is broadly performed in that the software (i.e. controller) of the gateway can transmit the packets without subject to expansion/compression using a broad but reasonable interpretation of the recited claimed subject matter.

Examiner notes the reference also indirectly teaches a setting section using a broad but reasonable interpretation of the claim. Examiner notes specifically that Vargo teaches selecting a codec 222 based on speech quality 221 at a voice port 61 (figure 11(b)) where it would have been obvious to a skilled artisan prior to applicant's invention that the speech quality is dependent on the transmission link which is dependent on other adjustable factors such as the transmission rate of the link. Specifically taught by the Vargo reference is adjusting such factors as redundancy, packet size and bundling for adjusting transmission rate in the gateway. For example, Vargo acknowledges, "packet redundancy effectively slows the data transmission rate because, due to replication, the information density is not as high" [column 5, lines 36-38]. In addition, other factors are also taught such as "a technique to eliminate dead air spaces in the voice data transmission stream by speeding up or slowing down the data rate in the buffer while maintaining a constant pitch in speech" [Abstract]. Thus Vargo provides a motivation for providing a broad but reasonable association between selecting a codec and the rate of transmission.

As to **claim 3**, in addition to the reasoning mentioned in claim 3, shown in figure 1 are multiple gateways connecting a circuit switched network (i.e., the PSTN) to an Internet Protocol (IP) network (i.e., the INET 17). Noted previously by the reference the software of the gateway is used to control the session information for the call including the port characteristics for the session.

As to **claims 4, 5 and 6**, examiner acknowledges that Vargo teaches codec selection in general for each gateway. Also taught could be not selecting a codec thus performing a Tandem Free Operation as is well known in the art to a skilled artisan prior to applicant's invention. Also taught by Vargo is selecting a codec based on speech quality should a codec not be detected.

Conclusion

4. Examiner's germane comment:

In general, examiner notes it is well known in the world of voice communications of the problem associated with repeated compression and decompression of coded voice samples (i.e., referred to by applicant as a repeated expansion/compression process). Such a process is known in the art as tandem voice coding. Examiner notes various examples in the prior art for trying to either minimize or eliminate (i.e., bypass) these tandem connections. For example, one prevalent example is known as performing tandem free operation (TFO) for end-to-end mobile-to-mobile communications. In this example a call runs from a mobile to another mobile through a series of switches (e.g., base stations and base station controllers), each of these switches possibly compressing/decompressing the voice samples. Thus a

need or motivation is created for eliminating this repeated compression/decompression (i.e., expansion and compression). Examiner notes various techniques are suggested for performing such a method such as using tones, reviewing the voice quality, or using the least significant bits (LSBs) of the voice sample as taught by the prior art (e.g., see U.S. Patent No. 5,956,673 to Weaver, Jr.). Examiner notes that applying the same techniques in general to a different scenario (e.g., a mobile-to-H.323 terminal call) would have been obvious since these techniques are directed towards solving the same problem (e.g., improving voice quality and minimizing delay). In other words, these switches could perform the same functionality as a generic gateway (e.g., a voice-over-IP gateway) when used to solve the same problem such that a gateway and switch are both performing the function of compression, decompression or bypassing a voice coding. Examiner also notes this is also applicable to general attributes or characteristics of a network in general such as a transmission rate. As such, applicant is strongly encouraged to keep this in mind especially in light of applicant's very broad independent claims.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US006256612B1 with respect to figures 3-5 showing CODEC establishment between a mobile and an H.323 terminal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225.


The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

Art Unit: 2663

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

Derrick W. Ferris
Examiner
Art Unit 2663

DWF 
November 21, 2002



MELVIN MARCELO
PRIMARY EXAMINER